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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,923	02/17/1998	DAN KIKINIS	P3295	8936

24739 7590 09/18/2006

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EXAMINER
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FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/024,923

Applicant(s)

KIKINIS, DAN

Examiner

Derrick W. Ferris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/17/2006 has been entered.

### *Response to Arguments*

2. This Office action is in response to applicant's paper filed 10/5/2005. **Claims 29-58** are pending. Applicant has canceled claims 20-28. Applicant has added claims 29-58.

3. The examiner **withdraws** the anticipated rejection to *Iwami* since applicant canceled the claims. As such, please find a new rejection for the newly added claims.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 29, 30, 34-37, 41-44, 48-51, and 55-58** are rejected under 35 U.S.C. 102(e) as being anticipated by over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*").

As to **claim 29**, *Iwami* discloses a bridge unit and a method comprising a trunk line port for receiving and placing COST telephone calls (i.e., fig. 1, between 20 and 3, inherently there's a port in order to connect the PSTN network to the server); a data

network port and circuitry for placing LAN calls (i.e., fig. 1 between 20 and 1, inherently there's a port in order to connect the server to the LAN); conversion between LAN and COST telephone calls (i.e., fig 7, 22, fig. 8, col. 11, II. 5-15); a lookup table (i.e., column 17, ll. 3-7) relating COST telephone numbers to IP addresses (i.e., column 15, ll. 41-54, the terminal may have a telephone number so the communication may be established and connection to take place) wherein control routine function, extract specific data to access the lookup table (i.e., fig. 18, col. 15, ll. 41-55, the extension and/or the terminal address has to be extracted in order to be compared) and enabling two people to engage in a live conversation and protocol conversion (i.e., fig. 8, col. 11, ll. 20 – column 12, ll. 15). See processor 17 in figure 6 with respect to a processor for the bridge.

As to **claim 30**, the public network 3 is the PSTN.

As to **claims 34**, see e.g., figure 5 which shows a flow chart of call negotiation from the PSTN to a packet-based network.

As to **claims 35**, see also figure 5 with respect to the voice mail option.

As to **claim 36**, see similar rejection to claim 29.

As to **claim 37**, see similar rejection to claim 30.

As to **claim 41**, see similar rejection to claim 34.

As to **claim 42**, see similar rejection to claim 35.

As to **claim 43**, see similar rejection to claim 29.

As to **claim 44**, see similar rejection to claim 30.

As to **claim 48**, see similar rejection to claim 34.

As to **claim 49**, see similar rejection to claim 35.

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As to **claim 50**, see similar rejection to claim 29.

As to **claim 51**, see similar rejection to claim 30.

As to **claim 55**, see similar rejection to claim 34.

As to **claim 56**, see similar rejection to claim 35.

As to **claim 57**, see similar rejection to claim 29.

As to **claim 58**, see similar rejection to claim 29.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 31, 32, 33, 38, 39, 40, 45, 46, 47, 52, 53 and 54** is rejected under 35 U.S.C.

103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of U.S. Patent No. 6,198,738 B1 to *Chang et al.* ("*Chang*").

As such to **claim 31**, see similar rejection for the parent claim(s).

*Iwami* is silent or deficient to the further limitation that the LAN network includes the Internet. However, *Iwami* discloses that the communication terminal could be using TCP/IP or UDP/IP (i.e., column 17, ll. 44-58; voice communication may be adapted to support these protocols).

*Chang* teaches the further recited limitation above at e.g., figure 1, 20; column 1, ll. 13-25).

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that the network is the Internet.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As such to **claim 32**, see similar rejection for the parent claim(s).

*Iwami* is silent or deficient to the further limitation of a look up table relating telephone numbers to IP addresses. In particular, *Iwami* teaches using extension numbers, see e.g., figure 18.

*Chang* teaches the further recited limitation above at e.g., column 4, lines 6-25 since the ULS server contains a database of address translations.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that a translation table can also contain IP addresses.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to **claim 33**, in addition to similar reasoning used for claim 22, see e.g., figure 18 of *Iwami* where the IP address corresponds to the telephone number.

As to **claim 38**, see similar rejection to claim 31.

As to **claim 39**, see similar rejection to claim 32.

As to **claim 40**, see similar rejection to claim 33.

As to **claim 45**, see similar rejection to claim 31.

As to **claim 46**, see similar rejection to claim 32.

As to **claim 47**, see similar rejection to claim 33.

As to **claim 52**, see similar rejection to claim 31.

As to **claim 53**, see similar rejection to claim 32.

As to **claim 54**, see similar rejection to claim 33.

8. **Claims 32, 39, 46, and 53** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,604,737 A to *Iwami et al. et al.* ("*Iwami*") in view of GB 2 315 190 A to *Mitel*.

As such to **claim 32**, see similar rejection for the parent claim(s).

*Iwami* is silent or deficient to the further limitation of a look up table relating telephone numbers to IP addresses. In particular, *Iwami* teaches using extension numbers, see e.g., figure 18.

*Mitel* teaches the further recited limitation above at e.g., page 9 first full paragraph since the gateway provides a one-to-one mapping function between the user's telephone number and TCP/IP address.

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The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Iwami* by clarifying that a translation table can also contain IP addresses.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be in order to communicate with the greatest number of possible users. The motivation is also the desire to use the network that is most broadly available and therefore preferred.

As to **claim 39**, see similar rejection to claim 32.

As to **claim 46**, see similar rejection to claim 32.

As to **claim 53**, see similar rejection to claim 32.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

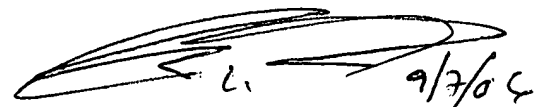


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DWF

Derrick W. Ferris  
Examiner  
Art Unit 2616

  
DERRICK W. FERRIS  
PRIMARY PATENT EXAMINER